

Appl. No. 10/054,113
Atty. Docket No. 8364M
Office Action dated: 21 December 2005
Reply Dated: 21 February 2006
Customer No. 27752

REMARKS

Claims 4, 5, 7-21, 23, and 24, are presently pending in the application. Claims 4, 5, 7-21, 23, and 24, are presently rejected. Herein, Applicants present no amendments to the claims, add no new claims, and cancel no claims. No additional claims fee is believed to be due.

FORMAL MATTERS

The Office Action has indicated that the formal drawings submitted on 16 September 2005 have been accepted.

The Office Action has also indicated that the objection to claim 8 has been withdrawn. Applicants, herewith thank the Office.

The Office Action further acknowledges that Applicants' arguments regarding Office's assertion about the location of the leading and trailing edges of the claimed patch is invalid are correct. However, the Office Action further states that such arguments are moot in view of the new rejection of claims under 35 U.S.C. 102(e) as anticipated by Schroeder (US Patent No. 6,124,522, hereinafter Schroeder). The Office Action then proceeds to characterize Schroeder patent in view of the arguments presented by Applicants in the paper submitted on 16 September 2005. Applicants have consolidated their response to these and other rejections by the Office below when responding to rejections under 35 U.S.C. 102(e) over Schroeder.

Rejection Under 35 U.S.C. 102(e) Over US Patent No. 6,124,522

Under the section entitled "Response to Arguments", the Office Action states that with respect to Applicants' arguments with regard to the rejection of claims 4-12 and 18-21, the Examiner disagrees. The Office Action then alleges that Schroeder teaches various arrangements of adhesive points, an example of which is not having side edge portions of substrate 4 at all and having adhesives 3, 5 disposed at the ends and a seal at end region 6, allowing the side edges of backsheets 1 to remain adhesive free ('522, Col. 5, lines 35-40). The Office Action concludes by alleging that this description of various arrangements is substantially identical in configuration to the claimed invention.

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Applicants submit that the Office Action mischaracterizes Schroeder when applying it to Applicants' invention. Applicants reproduce below the relevant portions of Schroeder (Col. 5, lines 30-43), for convenience:

The top cover sheet is longer and/or wider than the article, as is the bottom cover sheet, in order to provide end edge regions (6) or side edge regions (7) (or both) for sealing the top cover sheet to the bottom cover sheet around the article. Where there is no particular need for a sterile closure around the article, it is not necessary to provide all of the edge regions of the top and bottom cover sheets. For example, one could eliminate the side edge regions of both cover sheets, leaving a package held together at its end by first adhesive (3), second adhesive (5), and the seal formed at the end edge region (6) farthest from the second adhesive. Similarly, it would be possible to eliminate the end edge region farthest from the tab (8), leaving the package held together by bonds in the side edge regions (7).

Applicants submit that a proper reading of Schroeder discloses that one may eliminate the side or end edge regions if a sterile closure around the article is not required. However, Schroeder does not teach providing the side or end edge regions and not applying the adhesive to it. Therefore, it is incorrect on the part of the Office to conclude that the side edges are free of adhesive. There are no side edges in this instance. Thus, whatever may be the arrangement of top and/or bottom sheet with respect to the article, Schroeder recommends applying the adhesives uniformly to the top and bottom sheets (see further discussion below). Therefore, Applicants re-submit their argument that Schroeder teaches applying adhesive to entire surfaces, in contrast to the claimed invention which requires an adhesive contact area that comprises of a circumferential lateral edge 45, with its leading edge 46, trailing edge 47, and non-securing edge 48.

The Office Actions alleges that claims 4, 5, 7-11, 18, 19, 23, and 24, are anticipated in view of Schroeder ('522), under 35 U.S.C. 102(e).

The Office Action alleges that with respect to claims 4 and 11, first subsection (a), Schroeder teaches applicator substrate 4 having one surface coated with adhesive 15 and having tab 8 that extends laterally outward from substrate 4. Applicants respectfully traverse the rejection for the reasons set forth herein.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegal*

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Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987), MPEP §2131 (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989), MPEP 2131. The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831 (Fed. Cir 1990); emphasis added).

Schroeder teaches a pull tab that is formed by extending a segment of the top cover sheet beyond the end edge region and folding it under or toward the article. (Schroeder at Col. 6, lines 39-47, and Figures 1-5). Thus, Schroeder does not teach an applicator substrate that has a tab extending laterally outward from the substrate.

The Office Action also alleges that with respect to claims 4 and 11, first subsection (c), Schroeder teaches a bottom cover sheet 9 having an interior surface and a tab region 12 that extends laterally outward from said cover sheet and is laterally offset from tab 8 (Fig. 1) (Col. 5, lines 12-17). Applicants respectfully traverse the rejection for the reasons set forth herein.

Schroeder provides an anchoring or a tab region 12 that may be used to hold the bottom cover sheet fixed during application of the article or as a location to which a fastener can hold a stack of the packaged articles together. Schroeder teaches that tab 12 is at the same end as the pull tab 8 is formed. Further, Schroeder discloses that the tab is folded under or toward the article and away from the anchoring region. Therefore, Schroeder teaches tabs that are situated vertically with respect to the cover sheets that they extend from, not laterally, as the Office Action alleges.

Importantly, Schroeder does not teach that tab 12 is offset laterally from tab 8. In fact, Schroeder cautions that the tabs should not be offset laterally when he explains, "It will be apparent that the tab 8, the second adhesive 5 and the anchoring region 12 must all be located at the same end of the article in order for this peeling action to detach the article from the release layer 13 of the bottom cover sheet while keeping the article attached to the top cover sheet." (Schroeder at Col. 6, lines 50-55; emphasis added). Schroeder then backtracks and says that the anchoring region may be located adjoining the side edge. However, all the teachings and embodiments in Schroeder strongly advocate keeping the tabs aligned vertically to assemble a functional package, as can be seen in Figures 1, 2, 4, and 6. Therefore, Applicants submit that Schroeder does not teach tabs that are offset laterally from each other.

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The Office Action also alleges that with respect to claims 4 and 11, Schroeder teaches article back sheet 1 that provides a circumferential edge defined by the edge of gauze pad 14 (Figs. 2, 4, 5). Back sheet 1 has a leading edge in end region 6 (where tabs 8 and 12 are located), and a trailing edge longitudinally opposed, or distal relative to, the leading edge and tabs 8 and 12 (Fig. 1). The leading and trailing edges have adhesive 3 disposed on the interior surface, however, the side edges would not, as that adhesive area would be occupied by the upper surface of gauze pad 14 and therefore are non-secure edges. Applicants respectfully traverse the rejection for the reasons set forth herein.

Applicants submit that the Office Action again mischaracterizes Schroeder. Schroeder certainly provides that an adhesive sided article is made up of a backing sheet 1 with a first adhesive 3 disposed on one surface (Schroeder at Col. 4, lines 32-34). However, the alleged edges; the alleged leading edge 6, and the alleged trailing edge at the distal end of the tabs 8 and 12; are defined by Schroeder with respect to top cover sheet 4 and bottom cover sheet 9, respectively, and not with respect to backing sheet 1. As to the coating of the top and bottom cover sheets, Schroeder discloses:

The top and bottom cover sheets are preferably secured together by treating each with a nonadhesive bonding material (a "cohesive") that adheres only to other surfaces coated with the same material, but does not adhere to untreated surfaces such as backing sheet. This choice facilitates the assembly of the packaged article because it allows the entire inside surface of the top and bottom sheets to be coated with cohesive without concern that the adhesive sided article might adhere to the top cover sheet. Thus, layer (15) is disposed on the bottom of sheet (4) and layer (16) is disposed on the top of sheet (9). (Schroeder, Col. 4, lines 44-54; emphasis added).

Thus, Schroeder teaches applying a cohesive to entire surfaces, without creating a leading edge and a trailing edge, while Applicants invention provides for an adhesive contact area that comprises of a circumferential lateral edge 45, with its leading edge 46, trailing edge 47, and non-securing edge 48. Therefore, the Office Action's contention that area occupied by the upper surface of gauze 14 forms a non-secured edge is erroneous, as there are no leading and trailing edges neighboring it.

The Office Action further alleges, "Similarly, adhesive region 15 disposed on the interior surface of substrate 4, has an adhesive contact area having a leading edge in end region 6 and a trailing edge distal of said leading edge. Since these leading and trailing

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edge regions are part of an adhesive contact area, said regions are capable of tacking the corresponding edges of said article to the interior surface of substrate 4. Applicants respectfully traverse the rejection for the reasons set forth herein.

As argued above, Schroeder does not disclose a leading edge, a trailing edge, or a non-securing edge. In fact, Schroeder realizes that applying cohesive layers 15 and 16 to bottom of sheet 4 and top of sheet 9, respectively, does not ensure a selective removal of bottom sheet leaving the article and the top cover sheet together. Therefore, Schroeder adds yet another narrow strip 5 with adhesives 5a and 5b of differing strengths to ensure that when the top cover sheet is removed, the second adhesive component will be removed with it rather than adhering to the backing sheet. In fact, Schroeder cautions at Col. 6, lines 19-25, "When the top support sheet is removed from the adhesive-sided article, it is grasped at the end that has popped up or that is not adhered to the article and pulled lengthwise, not straight up. Thus, layer 5a releases from article 1 to pull-away from the receiving surface."

Thus, Schroeder's invention requires various layers of adhesives and cohesives, namely, 3, 13b, 5a, 5b, 15, and 16, to create a package-enclosed adhesive patch, while Applicants have invented an applicator device that achieves a similar objective by providing an adhesive contact area that comprises of a circumferential lateral edge 45, with its leading edge 46, trailing edge 47, and non-securing edge 48, which Schroeder does not disclose. Therefore, Applicants submit that Schroeder does not anticipate claims 4 or 11, and the rejections should be withdrawn.

The Office Action has also rejected claims 18 and 19, as allegedly being anticipated by Schroeder, since backsheet 1 is rectangular, any of the four edges adjacent the edge of gauze pad 14 will comprise about 25% of the total perimeter of the backsheet 1. The Office Action further alleges that since the leading edges are shorter than the side edges, the trailing and leading edges will likely constitute less than 50%, and thus between them each will constitute less than 25% of the total perimeter. As argued above, Schroeder does not anticipate independent claim 4. Further, recent case law states, "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000). The Office Action is relying on the drawings of Schroeder to show a "particular size" (e.g., area of the edges adjacent to the gauze pad), while the specification of Schroeder is silent as to the area of the edges. In light of the

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holding of the Federal Circuit, the Office Action may not read a precise percent value from the drawings. Thus, Applicants submit that Schroeder does not anticipate claims 18 or 19.

The Office Action has also rejected dependent claims 5, 7, 24, 8, 9, 10, and 23, as allegedly being anticipated by Schroeder. Applicants submit that in view of the arguments presented above, independent claim 4, and therefore, the claims that are dependent thereof, including claims 11, 5, 7, 24, 8, 9, 10, 18, 19, and 23, are not anticipated by Schroeder.

Rejection Under 35 U.S.C. 103(a) Over US Patent No. 6,124,522 (Schroeder)

The Office Action alleges that claims 20 and 21 are rejected as being unpatentable under 35 U.S.C. 103(a) over Schroeder ('522). Applicants respectfully traverse the rejection for the reasons set forth herein.

Applicants respectfully submit that the Office has failed to make a *prima facie* case for the obviousness rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or combine the references' teachings. See *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP §2143.01. Second, there must be reasonable expectation of success. See *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991); MPEP §2143.02. Third, the prior art reference or the combined references must teach or suggest all the claim limitations (Emphasis added). *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP §2143.03. Furthermore, in establishing a *prima facie* case of obviousness, case law clearly places the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967).

Schroeder is concerned with addressing problems hindering the ease and effectiveness of applying package-enclosed adhesive [patches] (e.g. Col. 2, lines 48-63). However, as argued above in response to the rejections by anticipation, Schroeder does not disclose or teach a circumferential lateral edge comprising a leading edge, a trailing edge, or a non-securing edge. The Office Action alleges, citing *In re Aller*, 105 USPQ 233 (CCPA 1955), that although Schroeder does not teach that the leading edge contact

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area comprises an area in the range of 0.4-2 cm², this merely constitutes an optimization of the value of the contact area, and therefore is within the routine skill in the art. Applicants respectfully traverse the rejection for the reasons set forth herein.

As the Office Action has correctly pointed out, Schroeder does not teach a leading edge contact area. Further, as argued above, Schroeder applies adhesives to entire surfaces, and does not teach or suggest a leading edge contact area. Moreover, there is no motivation in Schroeder to take his teachings and combine with the knowledge in the art to arrive at the concept of leading edge contact area, let alone deriving a specific range for such a leading edge contact area.

Moreover, "[w]hen applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (1) The claimed invention must be considered as a whole; (2) the reference must be considered as a whole and must suggest the desirability and thus the obviousness of making the contribution; (3) the reference must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (4) reasonable expectation of success is the standard with which obviousness is determined". (Emphasis added). *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1145 n.5, (Fed. Cir 1986), MPEP 2141.02. In short, under the "invention as a whole" test for 35 U.S.C. 103, the Office must take into consideration the presence of laterally offset tabs and the circumferential lateral edge comprising of a leading edge, a trailing edge, and a non-securing edge – factors that are not taught or suggested by Schroeder. Therefore, Applicants submit that Schroeder does not render claims 20 or 21 obvious.

Rejections under 35 U.S.C. 103(a) over US Patent No. 6,124,522 in view of US Patent No. 6,129,929, in view of Applicants' Disclosure, and in view of US Patent No. 6,043,406

Claim 12 is rejected under 35 U.S.C. 103(a) for allegedly being unpatentable over Schroeder in view of US Patent No. 6,129,929 (hereinafter Wick). Claims 13-15 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Schroeder in view of Applicants disclosure. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Schroeder in view of Sessions (U.S. Patent No. 6,043,406). Applicants respectfully traverse the rejections for the reasons set forth herein.

Claims 12, 13-15, and 16-17, are rejected based upon the Office's contention that Schroeder teaches the claimed invention. Applicants submit that in view of the above

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arguments, they have proven that a *prima facie* case of obviousness has yet to be made. Applicants also submit that the Office's rejections of claims 12, 13-15, and 16-17, must establish a *prima facie* case of obviousness of the invention including all of the limitations of claim 4, from which aforementioned claims all depend either directly or indirectly. As such, Applicants submit that Wick, Sessions, or Applicants' disclosure, do not remedy the failure of Schroeder (argued above and renewed here) to teach or suggest all of the claim limitations of Applicants' invention. Further, Schroeder does not provide motivation to combine Schroeder with any one or more of the cited references to arrive at Applicants' invention, at least because each of the references fails to teach the presence of tabs that are offset laterally and the circumferential lateral edge comprising of a leading edge, a trailing edge, and a non-securing edge, alone or in combination with Schroeder. As such, Applicants submit that the rejections are improper and should be withdrawn.

CONCLUSION

In light of the above remarks, it is requested that the Office reconsider and withdraw the pending rejections, and allow the pending claims. Early and favorable action in the case is respectfully requested.

Respectfully Submitted,

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